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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/555,091

11/02/2005

Michael Held

WI 1957 PCT-US

9357

7590 10/09/2008
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EXAMINER

YAN, REN LUO

ART UNIT

PAPER NUMBER

2854

MAIL DATE

DELIVERY MODE

10/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/555,091	Applicant(s) HELD ET AL.	
	Examiner Ren L. Yan	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-54 is/are pending in the application.
- 4a) Of the above claim(s) 29-33 and 35-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11-2-05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election with traverse of Group IV, claims 28 and 34 in the reply filed on 6-25-2008 is acknowledged. The traversal is on the ground(s) that the primary reference relied on by the Examiner in the subject application did not give rise to a holding of lack of unity in the International Search Report in the corresponding PCT application and therefore, the lack of unity position taken by the Examiner in the subject application is being applied in a narrow, literal or academic approach. This is not found persuasive because first of all, the U.S. patent and trademark office is an independent patent authority and its Examiners make their own independent evaluations on the issues presented in the applications filed in the U.S. Secondly, the holding of lack of unity position taken by the Examiner was based on a combination teachings of U.S. patent No. 3,762,697 and U.S. patent No. 5,692,440 which render independent claim 28 unpatentable. As a result, each of the invention Groups as set forth in the restriction requirement presents a special technical feature(s) that is not shared by the other Groups. Since applicant did not argue this finding of the Examiner, applicant must have agreed with the Examiner that invention Groups I-XIV do not relate to a single general inventive concept under PCT Rule 13.1.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 28 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolza-Shunemann(3,762,697) in view of Hillebrand(5,692,440).

The 3,762,697 patent teaches a wheel folding apparatus comprising: a transport cylinder 105 adapted to receive and to transport at least one web of material 101; first and second folding rollers 107 associated with said transport cylinder and defining a folding gap; a first counter cylinder 103 cooperating with said transport cylinder and defining a first cutting gap; and means on said transport cylinder and said first counter cylinder to transversely cut said at least one web of material. See Fig. 1 in the 3,762,697 patent for details.

However, the 3,762,697 patent does not teach a second counter cylinder cooperating with said transport cylinder and defining a second cutting gap.

The patent to Hillebrand teaches in a similar web folding apparatus the conventionality of using two cutting cylinders 8 and 9 cooperating with the transport cylinder 4 so as to vary the lengths of the signatures being cut. See Figs. 1 and 2, and column 2, lines 1-32 in Hillebrand for example.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the wheel holding apparatus of the 3,762,697 with the dual cutting cylinders appropriately disposed cooperating with the transport cylinder as taught by Hillebrand in order to predictably obtain product of various lengths as desired.

With respect to claim 34, the combination as applied above teaches the first and second counter cylinders arranged on said transport cylinder offset in a circumferential direction of said transport cylinder.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren L. Yan whose telephone number is 571-272-2173. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ren L Yan/
Primary Examiner, Art Unit 2854
October 5, 2008